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APPLICATION NO. 327	FILING DATE 04/19/97	WUJEBN FIRST NAMED INVENTOR	ATTORNEY DOCKET NO. 29865
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IM21/0623

EXAMINER CHERRER, C

ART UNIT 1751	PAPER NUMBER
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DATE MAILED: 06/23/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/776,321

Applicant(s)
Wubben et al

Examiner
Curtis E. Sherrer

Group Art Unit
1761



☒ Responsive to communication(s) filed on Mar 27, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 18-42 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 18-42 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

Drawings

1. The proposed drawing correction filed on 03/27/98 has been disapproved because it is not in the form of a pen-and-ink sketch showing changes in red ink or with the changes otherwise highlighted. See MPEP § 608.02(v).
2. The drawings are objected to because the chromatograms of Figs. 7A and 7B are of very poor quality, so as to be unviewable. Correction is required. The insertion of new matter should be avoided.

Claim Rejections - 35 USC § 112

3. Claims 18 to 42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
4. Applicants have added the phrase “adding one or more pectins to the beverage at a stage of the preparation process of said beverage effective to prevent any substantial breakdown of said pectins” (Claim 18).
5. Claims 18 to 42 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Claim 20 is considered indefinite because there is no antecedent basis for the phrase "the hop plant."
7. Claim 38 is considered indefinite because it is not seen how it further limits Claim 37.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

9. Claims 18 to 24, 28 to 39, 41 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Papazian (The New Complete Joy of Home Brewing, page 64) as evidenced by The Practical Brewer (pages 138-39) for the reason set forth in the last Office Action.

10. Claims 18 to 24, 28 to 39, 41 and 42 are rejected under 35 U.S.C. 102(e) as being anticipated by Lutzen et al (Homebrew Favorites, pp. 80 and 81) as evidenced by The Practical Brewer (pages 138-39).

11. Lutzen et al teach the recipe of "Magin's Strong Ale," whereby 3/4 of an ounce of Hallertauer pellets are added 20 minutes before the end of the boil, 1 ounce of Kent Goldings pellets are added 5 to 10 minutes before the end of the boil, 1 ounce of Cascade hop pellets are

added 5 minutes before the end of the boil and then 1/4 ounce of Cascade hop pellets are added to "steep." As previously stated in the last Office Action, in view of The Practical Brewer it is inherent that Lutzen et al teach the claimed invention.

12. Claims 18, 21, 36 to 38 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Bukovskii et al. (S.U. Pat. No. 685689) for the reasons set forth in the last Office Action.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 24, 25, 27, 29, 31 and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bukovskii et al for the reasons set forth in the last Office Action.

15. Claims 19, 20, 22, 23, 26, 28, 30, 32 to 35, 40 and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bukovskii et al in view of The Practical Brewer and in further view of Food Colloids (pp. 418-35) for the reasons set forth in the last Office Action.

16. Applicants have not set forth any persuasive reasoning why it would not be obvious to those in the brewing arts to use hop pectins in the various amounts, as claimed, at varying times, i.e., before a well known beer filtration step, or before a certain time at the end of boil, as claimed, and therefore it is considered that it would have been obvious to those of ordinary skill in the art to use hops in the manner taught or known in the prior art to obtain the expected results, i.e., better foam stabilization.

Response to Arguments

17. Applicants' arguments filed 03/27/98 have been fully considered but they are not persuasive.

18. Applicants discuss how the claimed process decreases the breakdown of hop pectins by decreasing the length of time that the hops are boiled in a wort. First, the broad claims are not limited to hops or beer, etc. For example, the pectin of the declaration was pectin extracted from spent hops and this limitation is nowhere found in the claims. Second, because the declaration provides a showing for what the Examiner considers to be inherently disclosed in the prior art process the prior art rejection are still considered proper. It is respectfully noted that case law has held that the observation of still another beneficial result in an old process cannot form the basis of patentability. *Allen v. Coe*, 57 U.S.P.Q. 136 (1943), *In re Jones*, 1941 C.D. 686.

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19. A review of the declaration shows that molecular weight of pectins are significantly broken down within 5 minutes of boiling. Therefore, it is not clear what the scope of “at a stage . . . to prevent any substantial breakdown of said pectins.” Claim 24 is directed to 30 minutes of boiling the molecular weight (average?) has decreased from about 300 Kda to around 175 Kda a decrease of about 125. At 10 minutes it had dropped to around 250 Kda, a decrease of about 50. It is considered that these would be considered “substantial breakdown.” In comparison, going from boiling to 30 minutes to 60 minutes the decrease only goes down to about 150 Kda, a drop of only 25. If boiling for 30 minutes is not considered “substantial breakdown,” why is 60 minutes “substantial?” In view of Applicants’ broad use of the claim phrasing, the claims have similarly been broadly interpreted.

20. Lastly, and again, the Office does not have the facilities for examining and comparing Applicant’s product with the product of the prior art in order to establish that the product of the prior art does not possess the same material structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed products and processes are functionally different than those taught by the prior art and to establish patentable differences. See *In re Best*, 562 F.2d 1252, 195 U.S.P.Q. 430 (CCPA 1977); *Ex parte Gray*, 10 U.S.P.Q.2d 1922, 1923 (BPAI).

Conclusion

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21. No claim is allowed.

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

23. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Monday through Friday from 6:00 to 2:30.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lacey, can be reached on (703)-308-3535. The fax phone number for this Group is (703)-305-3602.

26. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



Curtis E. Sherrer

June 18, 1998